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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,620	03/29/2001	Daniel G. Streibig	4052-7414	4111

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT PAPER NUMBER

2873

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,620

Applicant(s)

STREIBIG, DANIEL G.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,10 and 22-44 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-7 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5, 7, 10
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 46
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group II, claims 22-44 in Paper No. 11 is acknowledged.

### ***Specification***

The pages of the specification, abstract and claims were not numbered as required by the MPEP. For applicant's information the examiner has numbered the pages of the specification as pages 1-12, the pages of the claims as pages 13-18 and the abstract as page 19 accordingly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neefe patent no. 4,701,038.

Neefe discloses the limitations therein including the following: a colored contact lens (abstract, column 2, line 22); comprising a non-opaque pupil section (Figure 4, "3", column 3, line 22); a generally annular-shaped iris region surrounding the pupil region (Figure 4, "1"). The iris region of Neefe will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 4. Neefe further discloses the pattern comprising distinct elements with at least 25% having a surface

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area no greater than 6000 or 1000 square microns (column 3, line 25 and claim 1 with each "reflecting particle" being the claimed "distinct element"). In reference to the claimed "multi-color" pattern, Neefe further discloses that the coloring can comprise "pigments" (plural) being mixed together (column 2, line 22 to column 3, line 32) which would make obvious to a person of ordinary skill in the art the pattern being multi-colored. Regardless, it is well known in the art of colored contact lenses for such lenses to include more than one coloring in the iris section in order to provide a lens of a more natural appearance. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the iris portion of Neefe as "multi-colored" since it is well known in the art of colored contact lenses for such lenses to include more than one coloring in the iris section in order to provide a lens of a more natural appearance.

Claims 22-27 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo et al document number 2002/0039172 (hereinafter referred to as "Ocampo'172").

In reference to claims 22-27, Ocampo'172 discloses the limitations therein including the following: a colored contact lens (abstract) comprising a non-opaque pupil section (Figure 1, "20", section "0027"); a generally annular-shaped iris region surrounding the pupil region (Figure 1, "22", section "0027"). The iris region of Ocampo'172 will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 1, as well as it being well known that colored contact lenses have iris regions that cover a majority of the iris portion. Ocampo'172 further

discloses that the coloring is made up of "pigments" that are 3 microns or smaller ("0066"). Each of these pigments that make up the coloring can be considered as a "distinct element" and therefore each of at least 25% would have a surface area no greater than 6000 or 1000 square microns. Regardless, if one considers each of the pixels (instead of each of the pigments) as the "distinct elements", then having a pixel size of less than 88 microns in diameter would satisfy the limitation of claim 22.

Ocampo'172 teaches that the coloring can be applied by ink-jet printing ("0063-0064") and further that preferred ink-jet printers have pixels less than 150 microns in diameter and more preferably less than 100 microns in diameter to provide printing of greater quality ("0083"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the "distinct elements" of Ocampo'172 as having a surface area no greater than 6000 square microns since Ocampo'172 teaches that it is desirable for the diameter of the pixels to be less than 100 microns and for the desirability of having smaller pixel sizes for the purpose of providing printing of greater image quality. Furthermore, applicant is claiming that the pixel sizes should be smaller and smaller i.e. less than 4000 square microns, less than 2000 square microns, less than 1000 square microns which modification would involve a mere change in size of a component. It has been held that a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, as stated above, Ocampo'172 teaches of the desirability of pixel sizes being smaller and smaller including less than 100 microns in diameter (7,850 square microns) and therefore, applicant's claims of "less than 6000 square microns, less than

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4000 square microns etc” is merely optimizing a disclosed range. It has been further held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

In reference to claims 41-42, Ocamp’172 discloses as is set forth above but does not specifically disclose the claimed “at least twenty five different colors”. However, Ocamp’172 teaches that the number of colors can be manipulated through software and that the more colors used, the closer the lens approximates the human eye (“0013”). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens of Ocampo’172 as comprising at least twenty-five different colors since Ocamp’172 teaches that the number of colors can be manipulated through software and that the more colors used, the closer the lens approximates the human eye. Furthermore, Ocampo’172 teaches of the desirability of having many colors and the specific number of colors would be merely optimizing the range of colors. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

Claims 28-29 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo’172 in view of Atkins et al patent no. 6,132,043 (hereinafter referred to as “Atkins et al”).

In reference to these claims, Ocampo’172 discloses as is set forth above and further discloses that the patterning can be in the form of dots (“0039” and “0072”) but

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does not specifically disclose "at least 800" or "at least 3000" as claimed. Atkins et al teaches that the patterning can have "at least 800" or "at least 3000" dots to provide the required enhanced cosmetic appearance (Figure 1, column 2, lines 3-14). Atkins et al further teaches that the patterning can have more or less dots to provide the required cosmetic appearance (column 3, lines 32-36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the dot patterning of Ocampo'172 as comprising "at least 800" or "at least 3000" as claimed since Atkins et al teaches that the patterning can have "at least 800" or "at least 3000" dots as well as that the patterning can have more or less dots to provide the required cosmetic appearance. Regardless, the claimed number of dots of the patterning is again optimizing a range and as stated above, it has been further held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art *In re Aller*, 105 USPQ 233.

Claims 30-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocampo'172 in view of Tucker document no. 2001/0050753.

In reference to these claims, Ocampo'172 discloses as is set forth above including that the colored pattern can be applied by ink-jet printing ("0063"-0064") but does not specifically disclose the elements within 50 microns of each other. Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide improved printing quality (abstract, "0049", "0051").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

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the invention was made to have the elements of Ocampo'172 as being within 50 microns of each other since Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide improved printing quality. The claimed number of distinct elements is again optimizing the range of elements within the lens which optimization would be obvious to a person of ordinary skill in the art for the reasoning set forth above.

Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins et al in view of Tucker.

Atkins et al discloses the limitations therein including the following: a colored contact lens (abstract) comprising a non-opaque pupil section (Figure 1, "20", column 3, line 15); a generally annular-shaped iris region surrounding the pupil region (Figure 1). The iris region of Atkins et al will inherently cover at least 80% of the iris, this being reasonably based upon what is disclosed in Figure 1, as well as it being well known that colored contact lenses have iris regions that cover a majority of the iris portion. Atkins further discloses a multi-color pattern on the iris (column 3, line 56); the pattern comprising at least 3000 distinct elements (Figure 1 i.e. each dot being a "distinct element"). Atkins et al discloses as is set forth above but does not disclose each element within 10 microns of each other. Tucker teaches that when printing colored contact lenses, an inkjet printer can be used and that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns from each other to provide improved printing quality (abstract, "0049", "0051"). Therefore, it would have



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been obvious to a person of ordinary skill in the art at the time the invention was made to have the elements of Atkins et al as being within 10 microns of each other since Tucker teaches that when printing colored contact lenses through the use of an inkjet printer that the pixels i.e. the adjacent elements are preferably closer together including less than 50 microns (which would include less than 10 microns) from each other to provide improved printing quality.

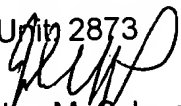
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Jordan M. Schwartz

Primary Examiner

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December 6, 2002